



IN THE UNITED STATES PATENT & TRADEMARK OFFICE

In re Patent Application of:

Michael Colin BEGG

Atty. Ref.: 34-125 – Conf. No.: 5698

Serial No.: 10/812,917

T.C./A.U.: 3729

Filed: March 31, 2004

Examiner: Anthony Dexter Tugbang

For: MANUFACTURE OF SHIM WINDINGS

* * * * *

September 11, 2008

MAIL STOP PETITION

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

PETITION PURSUANT TO 37 C.F.R. §1.181

Pursuant to 37 C.F.R. §1.181, applicant hereby petitions for relief from the restriction requirement being imposed by the Examiner in this application.

The Examiner initially made a restriction requirement in the office action mailed April 5, 2006, between (I) claims 1-4 drawn to a process of making an electrical coil, and (II) claim 5 drawn to the product of an electrical coil.

In applicant's response of August 3, 2006, a provisional election of invention I (i.e., the process of making the electrical coil) was elected with traverse. It was explained that in this instance, the final structure of the resulting coil is not the same as if made by some other process and that claim 5 was, in fact, a dependent product-by-process claim.



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In the Examiner's advisory action of June 4, 2007, the Examiner maintained the restriction requirement, arguing that MPEP section 2113 fully supports the Examiner's position "in that the final structure of Group II is not dependent upon the process of Group I." The Examiner also alleged that the "structure of Group II can be made by some other process, other than cutting or punching." The Examiner seems to ignore the fact that the restriction requirement is being made not only with respect to product-by-process claims versus method claims, but also allegedly between patentably distinct species of methodology (to which MPEP section 2113 does not appear to apply).

In applicant's appeal brief, footnote 1 at page 5 invited the Board's consideration and requested relief.

Now that we are back to the jurisdiction of the Examiner, this request for reconsideration and withdrawal of the outstanding restriction requirement(s) are again requested.

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Applicant notes that the Examiner relies on MPEP section 2113. However, MPEP section 2113 actually relates to patentability considerations – not to proper restriction practice. Furthermore, even when patentability considerations under 35 U.S.C. §103 are at issue, MPEP section 2113 specifically requires that:

The structure implied by the process steps should be considered when assessing the patentability of product-by-process claims over the prior art, especially where the product can only be defined by the process steps by which the product is made, or where the manufacturing process steps would be expected to impart distinctive structural characteristics to the final product. See, e.g., *In re Garnero*, 412 F.2d 276, 279, 162 USPQ 221, 223 (CCPA 1979) (holding “interbonded by interfusion” to limit structure of the claimed composite and noting that terms such as “welded,” “intermixed,” “ground in place,” “press fitted,” and “etched” are capable of construction as structural limitations).

Accordingly, contrary to the Examiner’s assertion in the final office action (which is reiterated to some extent in the advisory action and in the last office action), the product of the process claims here at issue can only be made by the claimed process of the respective parent claims. The Examiner’s assertion (e.g., see office action of February 15, 2007) that this argument is not “persuasive because the final structure of the product claims in Group I, whether this includes shared [sic: sheared] edges of the coil pattern or not, is not limited to the process steps recited in Group II” is not understood. Clearly, the structure implied by the process steps in a parent process claim does limit the

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claimed structure of product claims 5 and 10. Indeed, the section of the MPEP cited by the Examiner (i.e., section 2113) actually supports the applicant's argument.

The Examiner's assertion in the final office action of February 15, 2007, that "patterning by coating can generate to some degree, sharp edges, depending on how the pattern is coated" is not supported by any factual showing and, in any event, is either irrelevant or supports the applicant's argument. That is, even if it is true that coating can generate to some degree sharp edges, depending upon how the pattern is coated, it is still clear that the resulting product is different in structure from the product now being claimed which can only be created by the process of punching.

Thus, Applicant submits that the restriction requirement is inappropriate. In any case, claim 1 is generic to claim 5, and claim 6 is generic to claims 8, 9 and 10. Accordingly, once these generic claims 1 and 6 are found allowable, it should be understood that the withdrawn claims should also be allowed.

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It is not believed that any fee is required for consideration of this petition.
However, if any fee is required, then authority is hereby given to charge the same to our
Deposit Account No. 14-1140.

Respectfully submitted,

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